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EXAMINER

RAMAKRISHNAIAH, MELUR

ART UNIT	PAPER NUMBER
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2614

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/801,112

Applicant(s)

SHACHAR ET AL

Examiner

Melur Ramakrishnaiah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 and 53-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-50 and 53-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7-1-2004</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 7-9, 11-16, 18-19, 21, 24-30, 53-55, 57-60, rejected under 35 U.S.C. 103(a) as being unpatentable over Cruickshank (US PAT: 6,704,294, filed 10-13-1999) in view of Thomson et al. (US 2001/0056466A1, filed 12-19-2000, hereinafter Thomson)

Regarding claim 1, Cruickshank discloses a method comprising: accepting information regarding an audio communication session among a set of audio communication terminals (110/120, fig. 1), wherein each of the subset of audio communication terminals is associated with a data collaboration terminal (112, fig. 1), (col. 3, line 38 – col. 5, line 8).

Regarding claim 25, Cruickshank discloses a method comprising: receiving information regarding audio session among plurality of audio communication devices (112/120, fig. 1), for each of the audio communication device; determining which, if any, of a set of data collaboration terminals (112/122, fig. 1) are associated with the audio communication device (col. 3, line 38 – col. 5, line 8).

Regarding claim 53, Cruickshank discloses a device comprising: a controller in (114, fig. 1) to accept information regarding an audio communication session among a set of audio communication terminals (110/120, fig. 1), wherein each of a subset of

audio communication terminals is associated with a data collaboration terminal (112/122, fig. 1), using an audio communication terminal (col. 3, line 38 – col. 5, line 8).

Cruickshank differs from claimed invention in not specifically teaching initiating a data collaboration session for an associated data collaboration terminal, using a audio communication terminal.

However, Thomson discloses communication system for voice first collaboration which teaches the following: initiating a data collaboration session for an associated data collaboration terminal, using a audio communication terminal (paragraph: 0006; 0038).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Cruickshank's system to provide for the following: initiating a data collaboration session for an associated data collaboration terminal, using a audio communication terminal as this arrangement would provide one of the methods, among many possible methods, for establishing data collaboration session following audio session as taught by Thomson.

Regarding claims 2-4, 7-9, 11-16, 18-19, 21,24, 26-30, 54-55, 57-60, Cruickshank further teaches the following: step of initiating data collaboration session includes at least the step of sending a data collaboration request to the relevant data collaboration terminal (for example 122/510, figs. 1, 5), embedding a data collaboration request within a PSTN call (fig. 5, col. 6 lines 3-15), step of accepting information regarding an audio communication session includes at least accepting from a telephony network the addresses of the audio communication terminals, determining which of the

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set of audio communication terminals is registered in a database (118, figs. 1, 5), wherein data collaboration session is initiated if one of the audio communication terminals is registered in the database, comprising for each of the audio communication terminals (for example 110/112 or 110/510, figs. 1, 5), cross referencing the address of the audio communication terminal with the address of a data collaboration terminal (col. 4 lines 10-26), audio communication session includes permission information (this is implicit in as much as the collaboration cannot take place unless both parties agree), telephony network includes a PBX (114, fig. 1), data collaboration terminals communicate via an IP network (518, fig. 5), audio information for data collaboration is transmitted by the audio communication session, data collaboration includes the step of alerting the auto answer mode of the relevant data collaboration terminal (col. 4, line 66 – col. 5, line 8), accepting a request for a data collaboration session (col. 4 lines 59-65), determining at least two of the set of audio communication terminals are reregistered in a database (col. 4 lines 10-24), set of audio communication terminals are connected by a private branch exchange (114, fig. 1), the information is sent from the audio communication terminal using Dual-Tone Multi-frequency (col. 5 lines 37-39), step of starting data collaboration session includes at least transmitting a data collaboration request to the data collaboration terminal, an audio communication session includes at least the address of the audio communication device, the information regarding an audio communication session includes a telephone number, determining if an audio communication device is registered in a database (118, fig. 1), and determining an address of an associated data collaboration terminal (col. 4 lines 11-36), controller in

(114, fig. 1) is to accept from a telephony network the address of the set of audio communication terminals, the controller is to determine which of the set of the audio communication terminals is registered in a database (118, fig. 1), wherein data collaboration session is initiated if at least one of the audio communication terminals is registered in the database, the controller is to, for each of the audio communication terminals, cross reference the address of the audio communication terminal with the address of the data communication terminal, the audio information for data collaboration is transmitted by the audio communication session (col. 4 lines 11-36; col. 4, line 66 — col. 5, line 8).

3. Claims 32-36, 37-41, 42-44, 45-50, rejected under 35 U.S.C. 103(a) as being unpatentable over Thomson et al. (US 2001/0056466A1, filed 12-19-2000, hereinafter Thomson) in view of Fostick (US PAT: 6,856,809, filed 5-17-2001).

Regarding claim 32, Thomson teaches establishing server indicating that an audio session is taking place among a plurality of endpoints (figs. 1-2, 7), the internet location server (reads on 15, fig. 7) transmits a signal to the server, and server upon receipt of the signal, initiates a data collaboration between plurality of endpoints (paragraphs: 0006; 0022-025; 0027-0028; 0030; 0032-0049)

Regarding claim 45, Thomson discloses a method comprising: during an audio session between a plurality of users, receiving unique ID data from an audio communication terminal (paragraph: 0022), initiating a data collaboration session by a user, sending an indication to an audio communication terminal to initiate a data

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collaboration session, and remotely activating a data a data collaboration session (paragraphs: 0006; 0022-025; 0027-0028; 0030; 0032-0049)

Regarding claims 33-36, 37-42, 43-44, 46-50, Thomson further teaches the following: database (paragraph: 0022) including data collaboration session enabled end points (112/512, fig. 6), server (11, fig. 2) transmits data collaboration request to the data collaboration terminal, signals indicating that an audio session is taking place include at least the address of an audio communication terminal, signals indicating that an audio session is taking place includes at least a telephone number, server is a videoconference server (implied in as much as the reference teaches conducting video conference, paragraph: 0005), the endpoints include audio communication terminals which communicate via PBX (paragraphs: 0017, 0038), endpoints include data collaboration terminals (fig. 2) which communicate via an IP network, audio information for data collaboration session is transmitted by the audio session , audio information is transmitted by DTMF, initiating data collaboration session includes the step of alerting an answer mode of the relevant endpoints, audio communication detection accepts a user request for data collaboration session, initiating registration application, thereby associating user's data collaboration terminal and audio communication terminal, putting the audio session on hold (this is implied as the users have to wait for setting up data session) to initiate a communication session with an SMS server (reads on 610, fig. 6), terminating the communication session and liberating the audio session, determining if there is a correlation between the ID data contained message and the data collaboration terminal associated with the ID data (figs. 9, 11), checking whether

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data collaboration terminals are on line and ready for the communication (paragraphs: 0006; 0022-025; 0027-0028; 0030; 0032-0049)

Thomson differs from claimed invention in specifically teaching SMS server and using SMS message for establishing data collaboration/of conference.

However, Fostick discloses SMS conference which teaches the following: SMS server and using SMS message for establishing data collaboration/of conference (figs. 1-3; abstract; col. 2, line 40 – col. 3, line 45).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Thomson's system to provide for the following: SMS server and using SMS message for establishing data collaboration/of conference as this arrangement would provide one of the methods, among many possible methods, for establishing a conference.

4. Claims 5, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cruickshank in view of Thomson as applied to claim 1 above, and further in view of Sullivan (US PAT: 5,351,296).

Regarding claims 5 and 22, the combination does not teach the following: silencing the DTMF data collaboration request.

However, Sullivan discloses financial transmission system which teaches the following: Silencing DTMF signals during transaction (col. 3 lines 48-54).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: silencing the

DTMF data collaboration request as this arrangement would facilitate the user to avoid damage and discomfort to the listener's ear during transaction as taught by Sullivan.

5. Claims 6, 23, 31, and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cruickshank in view of Thomson as applied to claims 1, 25, 53 above, and further in view of Fostick.

The combination differs from claims 6, 23, 31, 56 in that although it teaches implementing a data collaboration request using telephone call (see abstract); but does not teach the following: implementing a data collaboration request using SMS and transmitting audio information by SMS.

However, Fostick discloses SMS conference system which teaches the following: implementing a data collaboration request (reads on conferencing) using SMS and transmitting audio information by SMS (fig. 6, and see abstract).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Cruickshank's system to provide for the following: implementing a data collaboration request using SMS and transmitting audio information by SMS as this arrangement would provide one of the methods, among many possible methods, for initiating collaboration request as shown by Fostick.

6. Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cruickshank in view of Thomson as applied to claim 1 above, and further in view of Kerr (US PAT: 5,844,600).

Regarding claims 10 and 20, the combination does not teach the following: inserting delay in audio communication session.

However, Kerr discloses methods and apparatus and systems for transporting multimedia conference data streams through a transport network which teaches the following: inserting delay in audio communication session (see abstract).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: inserting delay in audio communication session as this arrangement would facilitate synchronizing information to suite application needs as taught by Kerr.

7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cruickshank in view of Thomson as applied to claim 1 above, and further in view of Hinderks (US PAT: 6,700,958, filed 7-3-2001, hereinafter Hinderks).

Regarding claim 17, the combination does not teach the following: audio data sent from the audio communication terminals is compressed with wide band audio.

However, Hinderks discloses method and apparatus for transmitting coded audio signals which teaches the following: audio data sent from the audio communication terminals is compressed with wide band audio (fig. 1, col. 3 lines 31-51).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: audio data sent from the audio communication terminals is compressed with wide band audio as this arrangement would facilitate wide band audio which can be transmitted with in the available ban width as taught by Hinderks.

Response to Arguments

8. Applicant's arguments filed on 11-24-2006 have been fully considered but they are not persuasive.

Rejection of claims 1-4, 7-9, 11-16, 18-19, 21, 24-30, 53-55, 57-60 under 35 U.S.C. 103(a) as being obvious over Cruickshank (US PAT: 6,704,294, filed 10-13-1999) in view of Thomson et al. (US 2001/0056466A1, filed 12-19-2000, hereinafter Thomson): regarding rejection of independent claims 1, 25, 53, using the above combination of references, Applicant argues that "where as according to claims 1, 25, and 53, "the audio communication terminals is associated with data collaboration terminal", contrary to what is claimed in 1, the Cruickshank reference teaches using two parallel networks, an audio and a telephone network. Whereas according to claims 1, 25, and 53, initiating a data collaboration session for an associated data collaboration terminal [is done] using an audio communication terminal, the Cruickshank reference ... although both the present application and the Cruickshank related to voice and data collaboration, claim 1 covers a completely different invention from the one taught or suggested in the Cruickshank reference". Contrary to applicant's interpretation of Cruickshank reference, he clearly teaches: audio communication terminals (110, 120, fig. 1) is associated with data collaboration terminals (112/122, fig. 1) as recited in the above claims (col. 4, line 66 – col. 5, line 7) . The secondary reference Thomson teaches initiating data collaboration session for an associated data collaboration terminal, using a audio communication terminal (paragraphs: 0006) and Thomson further teaches using various communication media such as PSTN, ISDN, PBX, etc, to

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undertake data collaboration after initiating audio communication (paragraph: 0038).

Therefore, the combination of Cruickshank and Thomson teaches limitation of claims 1, 25, 53, as indicated in the office action above. Regarding Thomson reference, Applicant argues that "Nowhere in the Thomson reference does it mention using a voice terminal to initiate a data collaboration session on a separate data collaboration terminal". Contrary to Applicant's interpretation of Thomson reference teaches the following: the telephone is used in the usual way to make regular, voice only, telephone calls. Once the call is established, the telephone communicates with each other to determine if they are each associated with equipment which would allow richer collaboration between their respective users (paragraph: 0006). This clearly reads on a using a voice terminal to initiate a data collaboration session on a separate data collaboration terminal. Further it appears that applicant is arguing against individual references to undermine claim rejections under 35 U.S.C 103(a). In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding rejection of the above claims, Applicant further alleges that "the Examiner failed to show suggestion or motivation to combine the teachings of the cited references at the time of the invention. Applicant submits that, at least at the time of invention was made, the teachings of the primary reference could not be considered to be analogues to what is taught in secondary reference, and therefore do not suggest a

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possible motivation to combine the two references". Regarding this, contrary to applicant's interpretation of references, both references Cruickshank and Thomson teaches establishing collaboration session after setting up of audio communication using telephone terminals and this clearly establishes that they are analogues art. Further, office action clearly shows motivation to combine the references such as: this arrangement would provide one of the methods, among many possible methods, for establishing data collaboration session following audio session as taught by Thomson. Applicant further argues that "Examiner has used impermissible hindsight to try to reconstruct the Applicant's invention by using the Applicant's structure as a template and selecting elements to fill the gaps". In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Applicant further argues about motivation to combine the references and desirability of the combination etc. As already explained both references Cruickshank and Thomson teaches establishing collaboration session after setting of audio communication using telephone terminals. Further, office action clearly shows motivation to combine the references such as: this arrangement would provide one of the methods, among many possible methods, for establishing data collaboration

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session following audio session as taught by Thomson. In view of this examiner submits that Examiner has established clear prima facie case of obvious rejection of the above claims.

Rejection of claims 32-36, 37-41, 42-44, 45-50, under 35 U.S.C. 103(a) as being obvious over Thomson et al. (US 2001/0056466A1, filed 12-19-2000, hereinafter Thomson) in view of Fostick (US PAT: 6,856,809, filed 5-17-2001):

Regarding rejection of the above claims, Applicant alleges that "Examiner has failed to establish a prima facie case of obviousness by failing to show motivation to combine the teachings of the two references. Regarding this examiner has clearly established a prima facie case of obviousness rejection and also provided motivation to combine the above references, viz: the office action clearly sets forth the following: Thomson differs from claimed invention in specifically teaching SMS server and using SMS message for establishing data collaboration/of conference.

However, Fostick discloses SMS conference which teaches the following: SMS server and using SMS message for establishing data collaboration/of conference (figs. 1-3; abstract; col. 2, line 40 – col. 3, line 45).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Thomson's system to provide for the following: SMS server and using SMS message for establishing data collaboration/of conference as this arrangement would provide one of the methods, among many possible methods, for establishing a conference.

Applicant further alleges that Thomson and Fostick are not analogous art. Regarding this, Thomson teaches establishing collaboration after initiating a telephone call or telephone message or audio message (paragraph: 0006) and establishing conference among users by sending SMS messages and using internet computers and servers to set up collaboration/conference among end points using SMS messages (figs. 1-3, col. 2, line 40 – col. 3, line 45; col. 6 lines 4-8). This clearly establishes that they are analogous art because both teach establishing collaboration/conference by exchanging messages before establishing collaboration/conference.

Applicant further argues "Examiner has used impermissible hindsight to try to reconstruct the Applicant's invention by using the Applicant's structure as a template and selecting elements to fill the gaps". In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant further argues that "More specifically, the secondary reference discuss initiating conference using sms. Whereas claim 32 recites: " internet location server transmits a signal to the server, and server upon the receipt of signal, initiates a data collaboration session between plurality of endpoints." This limitation is neither taught or

suggested by either reference". Regarding this, Fostick, the secondary reference, teaches the following: As described in fig. 1, a short message service entity, from which short message may be sent includes but not limited to: computers and servers on a wire line network (50), computers and servers on the internet (52), any internal system and wireless devices (53, col. 6 lines 4-8). This clearly shows sending messages to the internet servers and other servers to establish collaboration/conference between endpoints. Hence clearly reads on applicant's limitation: internet location server transmits a signal to the server, and server upon the receipt of signal, initiates a data collaboration session between plurality of endpoints. Therefore, the combination of Thomson and Fostick teaches applicant's claim limitations as set forth in the office action above.

In light of this explanation, rejection of the claims 1-50, 53-60 is maintained.

9. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

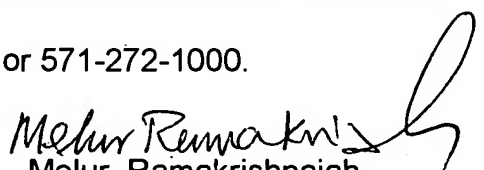
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melur Ramakrishnaiah whose telephone number is (571)272-8098. The examiner can normally be reached on 9 Hr schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curt Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Melur Ramakrishnaiah
Primary Examiner
Art Unit 2614